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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,623	09/26/2003	Steven Tysoe	134763	8056

41838 7590 08/10/2006

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EXAMINER	
LE, HOA T	

ART UNIT	PAPER NUMBER
1773	

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/672,623	**Applicant(s)** TYSOE ET AL.
	Examiner H. T. Le	**Art Unit** 1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: *None*.
   Claim(s) objected to: *None*.
   Claim(s) rejected: *1-7 and 25-36*.
   Claim(s) withdrawn from consideration: *None*.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see "Detailed Advisory Action".
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

H. T. Le
Primary Examiner
Art Unit: 1773

DETAILED ADVISORY ACTION

1. Applicant asserted that "the Final Office Action is defective in that it does not set forth a basis for rejection of most of the claims", namely claims 2, 25 and 31. Applicant is invited to carefully review the previous office actions. Claim 2 was rejected in the office action mailed September 25, 2005, at page 3, section 5. With regard to the added claims 25-36, claims 25 and 31 contain the same limitations as that of claim 2, except they are written in independent form. The rejection to these claims would have been the same as the rejection to claim 2, and of which the examiner discussed in the final rejection (paragraphs 2 and 2.2). All these rejections are hereby reproduced (see bolded paragraphs below) for Applicant's convenience.

From the office action mailed September 25, 2005 (page 3, section 5):

> **Claim 2: The '388 Moro patent also discusses an amount of insulating binder less than 0.3 wt% (col. 5, lines 13-15). "Disclosure of composition of matter in reference may be anticipatory even though reference indicates that composition is not preferred or even that it is unsatisfactory for intended purpose". In re Nehrenberg (CCPA), 129 USPQ 383.**

From the final rejection (page 2, paragraphs 2 and 2.2):

> **2. Claims 1-7 and 25-36 are rejected under 35 U.S.C. 102(e) as being anticipated by the Moro patent (US 6,940,388) as applied to the rejection to claims 1-7 set forth in the last office action and further discussed below.**

2.2. With regard to claim 2 (and also newly added claims 31 and 25), applicant argues that "the Examiner's reliance on *In re Nehrenberg* is misplaced" because "the MPEP now cites the case only in regards to use of the term "substantially". There is more than one issue in *In re Nehrenberg*. What applicant refers to is the 35 USC 112 issue that is not the patentability issue under 35 USC 102 that the examiner applied in the rejection.

Accordingly, Applicant's allegation of 'defective' final rejection is invalid and unsupported.

2. Applicant reiterates the same arguments, that is: (1) the Moro fails to teach elongated particles of claims 1 and 25 and (2) Moro teaches away from the range mentioned in the current claims 2, 25 and 31. These arguments were already raised by Applicant previously and have been addressed by the examiner in the final rejection. Therefore, there is nothing new for the examiner to reply. For Applican't convenience, the examiner reproduces her responses in the final rejection (see bolded paragraphs below).

2.1 Applicant argues that the Moro fails to teach elongated soft magnetic material because Moro discloses only spherical and flat and that a "'flat' particle does not imply an elongated particle." Note that Moro states "[t]he shape of the ferromagnetic metal powder, without any particular limitation, may be spherical or flat." (emphasis added) (col.3, lines 27-29). Thus, the magnetic material powder is not limited to just spherical or flat. Moreover, a flat shape broadly includes elongated shape. Particularly, at col. 3, lines 41-43,

Moro discloses a flat shape having an aspect ratio of 5 to 25, which ratio is clearly a description of an elongated shape. In addition, the elongated shape that applicant's argument relies on is not recited in claims 31-36.

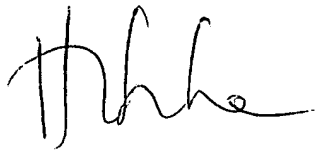
2.2. With regard to claim 2 (and also newly added claims 31 and 25), applicant argues that "the Examiner's reliance on *In re Nehrenberg* is misplaced" because "the MPEP now cites the case only in regards to use of the term "substantially". There is more than one issue in *In re Nehrenberg*. What applicant refers to is the 35 USC 112 issue that is not the patentability issue under 35 USC 102 that the examiner applied in the rejection.

2.3 Applicant further argues "Moro teaches away from the range mentioned in the current claim, stating simply that thinner coatings will not function at all." The ruling in *In re Nehrenberg* addresses precisely this issue; that is, "disclosure of composition of matter in reference may be anticipatory even though reference indicates that composition is not preferred or even that it is unsatisfactory for intended purpose". Thus, even though the range as claimed is disclosed as "not working at all" by Moro, as contended by applicant, it does not change the fact that such product exists and thus is anticipatory according to *Nehrenberg* ruling.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511. The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



H. T. Le
Primary Examiner
Art Unit 1773

August 6, 2006